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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/042,321

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Takeya Miwa

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08/20/2004

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EXAMINER

FIGUEROA, FELIX O

ART UNIT

PAPER NUMBER

2833

DATE MAILED: 08/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

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<b>Office Action Summary</b>	<b>Application No.</b> 10/042,321	<b>Applicant(s)</b> MIWA, TAKEYA	
	<b>Examiner</b> Felix O. Figueroa	<b>Art Unit</b> 2833	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 25 June 2004.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Claim Objections*

Claim 12 is objected to because of the following informalities: In line 12, "the at least" should be --at least--. Appropriate correction is required.

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1 and 2 are rejected under 35 U.S.C. 102(e) as being anticipated by Okamoto (US 6,343,942).

Okamoto discloses a lamp socket comprising: a socket body (12); a connector housing (see Fig.13) for accommodating a connector; a bulb-mounting portion (see Fig.11) for mounting a lamp; and a monolithic terminal member (30) provided within the socket body so that a wire, the connector and the lamp are electrically directly connected; and wherein the terminal member is adapted to contact the connector, the lamp, and at least one of the wires. Regarding the limitation "adapted to contact...", please note that it has been held that the recitation that an element is "adapted to" perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ

138. Please note that the terminal member of Okamoto is capable of contacting the connector, the lamp and at least one wire.

Regarding claim 2, Okamoto discloses the socket body provided with a wire connection portion (36).

Claims 1, 2, 6-8, 12, 15, 17 and 20 are rejected under 35 U.S.C. 102(e) as being anticipated by Applicant's Admitted Prior Art (Figures 7-10).

Applicant's APA shows a lamp socket comprising: a socket body (1); a connector housing (1c) for accommodating a connector; a bulb-mounting portion (1a) for mounting a lamp; and a monolithic terminal member (2) provided within the socket body adapted to electrically directly connected a wire, the connector and the lamp. Regarding the limitation "adapted to contact...", please note that it has been held that the recitation that an element is "adapted to" perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138. Please note that the terminal member of the APA is capable of contacting the connector, the lamp and at least one wire.

Regarding claim 2, the APA discloses the socket body provided with a wire connection portion (below flange 1b).

Regarding claim 6, the APA discloses a socket assembly (Fig.9) comprising: a lamp unit body (5); a plurality of lamp sockets (1A, 1B and 1C) mounted on the lamp unit body and connected through wires (7), each lamp socket including: a socket body (1); a connector housing (1c) for accommodating a connector; a bulb-mounting portion (1a) for mounting a lamp; and a terminal member (2) provided within the socket body so

that a wire, the connector and the lamp can be electrically directly connected.

Regarding the limitation "adapted to contact...", please note that it has been held that the recitation that an element is "adapted to" perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138. Please note that the terminal member of the APA is capable of contacting the lamp and at least one wire.

Regarding claim 7, the APA shows the lamp sockets being connected to one another by wires of different lengths (Fig.9).

Regarding claim 8, the APA discloses the socket body provided with a wire connection portion (below flange 1b).

Regarding claim 12, APA shows a socket assembly comprising: a lamp unit body (5); and a plurality of lamp sockets (1) mounted on the lamp unit body and electrically connected together through wires (7), each of the plurality of lamp sockets comprising: a socket body (1) including a wire connection portion (below flange 1b); a connector housing (1c) for accommodating a connector (13) to the socket body, a bulb mounting portion (1a) for mounting a lamp (3) to the socket body; and a terminal member (2) provided within the socket body; wherein the terminal member is adapted to be electrically directly connected to the connector, the lamp, and at least one of the wires; wherein the terminal includes two ends, one end (at 1b) including a press-connecting portion (8) provided within the wire connection portion of the socket body, the press-connecting portion capable of directly electrically connecting the terminal member to a conductor (11) of the at least one of the wires, wherein another end (at 1c) of the two

ends has a connector portion that projects into the connector housing for directly electrically connecting the terminal to the connector, and wherein the lamp contacts a portion of the terminal member between the press-connecting portion and the connector portion (see Fig.7). Regarding the limitations "capable of contacting...", please note that the recitation that an element is "capable of" perform a function is not a positive limitation but only requires the ability to so perform.

Regarding claims 15 and 20, APA discloses the one end (at 1b) including a press-connecting blade (9) which can bite into a sheath of the at least one of the wires to electrically connect the terminal member to the conductor of the at least one of the wires, and the other end (at 1c) including a male tab projecting into an interior of the connector housing for directly electrically connecting to the connector.

Regarding claim 17, APA discloses the terminal member (2) being a monolithic structure.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3, 4, 9, 10, 13, 16 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant's Admitted Prior Art (Figures 7-10) in view of Tanigawa (US 6,086,408).

Applicant's APA discloses substantially the claimed invention except for the wire insertion grooves in which the terminal member is mounted. Tanigawa teaches a socket assembly (Fig1) comprising a plurality of lamp sockets, each having a socket body (Fig.4), a bulb mounting portion (32), a terminal member (23K); the socket body including a wire connection portion (see Fig.7) including wire insertion grooves in which the terminal member is mounted, and the terminal member including at one end a press-connecting blade (40K) which can bite into a sheath of a wire to electrically connector to a conductor of the wire to provide a more stable and secure connection between the blade and the wire. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to form the socket body of the APA having the wire connection portion including wire insertion grooves in which the terminal member is mounted, as taught by Tanigawa, to form a more stable and secure connection between the blade and the wire.

Regarding claims 4 and 10, the APA shows the bulb in contact with a portion of the terminal member between the press-connecting blade and the male tab.

Regarding claim 16, see discussion on claim 15.

Claims 5, 11, 14, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant's APA and Tanigawa, and further in view of Mews et al. (US 5,931,691).

The APA, as modified by Tanigawa, discloses substantially the claimed invention except for the opposed retaining projections. Mews teaches a lamp socket with a wire connection portion including a wire insertion groove (24) with opposed retaining

projections (near 43 in Fig.1) at an end of an opening (please note that the projections are at a top end of the opening), and a distance between the opposed retaining projections is smaller than an outer diameter of the at least one of the wires to tightly retain the wire in the insertion groove. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to form the wire insertion groove of Tanigawa with opposed retaining projections, as taught by Mews, to tightly retain the wire in the insertion groove.

### ***Response to Arguments***

Applicant's arguments filed June 25, 2004 have been fully considered but they are not persuasive.

In response to Applicant's arguments regarding claims 1 and 6, it is noted that it has been held that the recitation that an element is "adapted to" perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138. Please note that the terminal members of Okamoto and the APA are capable of contacting the connector, the lamp and at least one wire.

In response to Applicant's arguments regarding claim 12, please note that that the recitation that an element is "capable of" perform a function is not a positive limitation but only requires the ability to so perform.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP



§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Felix O. Figueroa whose telephone number is (571) 272-2003. The examiner can normally be reached on Mon.-Fri., 10:00am-6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paula A. Bradley can be reached on (571) 272-2800 Ext. 33. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 2833

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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